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09/635,330	08/09/2000	Luis Eduardo Gutierrez-Sheris	25153-003	5198

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3693

MAIL DATE	DELIVERY MODE
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06/22/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/635,330	Applicant(s) GUTIERREZ-SHERIS, LUIS EDUARDO	
	Examiner STEFANOS KARMIS	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 8-10, 14, 16, 18, 20, 24-26, 30-34, 40-44, 49, 50 and 62-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8-10, 14, 16, 18, 20, 24-26, 30-34, 40-44, 49, 50 and 62-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in reply to the remarks filed 29 April 2009.

Status of Claims

2. No claims are currently amended. Claims 1-3, 8-10, 14, 16, 18, 20, 24-26, 30-34, 40-44, 49, 50 and 62-64 are currently pending.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 April 2009 has been entered.

Response to Arguments

4. Applicant's arguments filed 29 April 2009 have been fully considered but are not persuasive.
5. Applicant argues that Downing does not disclose the use of a money pick-up device and corresponding pin to access transferred funds. The Examiner agrees with the Applicant, however, the Examiner notes that it is the combination of teachings which is relied on for the rejection of claim 1. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

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208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

1986). Therefore, it is the combination of Downing in view of Corder in further view of Risafi that teaches a money pick-up device and corresponding pin to access transferred funds.

Applicant has not provided arguments that the combination fails to teach this limitation.

Therefore, Applicant's arguments against Downing individually are not persuasive.

6. Applicant argues that Downing teaches away from Corder and Risafi and requiring a money pick up device and pin. The Examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Downing, Corder and Risafi are all in the field of Applicant's endeavor and related to the particular problem with which Applicant is concerned. Applicant's specification states that a need exists in the art for a money transfer system that is significantly easier and quicker to use by both transferring parties and beneficiaries. Downing teaches an invention for a system and method for convenient funds transfers (column 3, lines 40-53). Corder teaches a system and method for transferring value that easy for customers to use and relatively inexpensive for business to install and maintain (column 1, line 64-67 and column 2, line 66 thru column 3, line 30). Risafi teaches that the invention is used for transferring money between two cardholders (column 5, lines 11-17). Therefore, Downing, Corder and Risafi are all in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order

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to be relied upon as a basis for rejection of the claimed invention. Therefore the prior art is analogous.

Further Downing, does not teach away. Downing teaches providing a beneficiary with a unique device pick-up code (column 7, lines 6-17). Downing then teaches that a recipient uses CAT machine to receive the funds. Downing teaches that the CAT machines have card readers (column 4, lines 61-67), however, the card reader is not required for the recipient to access the funds. Specifically, Downing teaches a secret code selected by the sender at the time the transfer was requested as well as a transfer confirmation reference number generated by the system and printed on the receipt is all that is required (column 7, lines 6-17). The beneficiary uses a CAT and enters the secret code and reference number to obtain the request funds (column 7, lines 29-42). While Downing teaches that use of a CAT, which allows the beneficiary to obtain funds without a card/PIN, Downing also teaches that invention can be used in connections with ATMs (column 10, lines 34-36). Downing teaches the use of a PIN when reading the card of the transferor (column 10, lines 37-47). Downing further teaches differentiating pick-up codes from the sender's PIN to increase security in the system (column 9, lines 57-64).

Corder teaches a smart card system for transferring value (Abstract and title). Specifically, Corder teaches that a customer telephones the central server apparatus and requests a transfer of value, i.e. money from a pre-established account of the customer at a bank, to an account of the entity operating the stored value system (column 4, lines 27-44). After funds are verified, an authorization code (i.e. single use pick-up code) is provided to the customer (column 4, lines 54-67). Corder further teaches that once an authorization code is provided to a customer, the authorization code is deactivated, so that it cannot be provided to other customers (column 5,

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lines 3-8: single use). Continuing, the customer then goes to a value added terminal (ATM) and inputs the authorization code and the value added terminal can either obtain a supply of smart cards from which it can select one and program the card with the appropriate dollar amount (column 5, lines 22-33). After the value added terminal programs the smart card with the cash value, the authorization code is deactivated in a manner similar with the deactivation mentioned earlier (column 5, lines 46-54; Therefore the code can only be used one for a single transaction). The card is then dispensed to the customer who can use the card as electronic or digital cash at any number of money activated machines (column 6, lines 15-25). Corder fails to teach that the authorization code is provided from the customer to a beneficiary and instead the customer picks up the card himself. Risafi teaches that a card can be used to transfer money (column 9, lines 51-57). Risafi teaches cards can be purchased at a point of sale location, at an ATM, at any designated/approved card-dispensing device or from a card issuer or designated agent of the card issuer (column 6, lines 47-57). Risafi teaches issuing by a program sponsor to a card user a card with a PIN, in which the consumer (beneficiary) can even change the PIN if desired (column 6, lines 58-65). Risafi teaches that the card can be used to transfer money, including wire transfer (column 9, lines 27-57). Risafi also teaches that a program sponsor can cause the card to be issued on behalf of a card user and assign a PIN to the card (column 6, lines 48-64). Risafi teaches that issuers or agents can sell or distribute card to card users or they can be obtained at a standalone terminal (column 10, lines 1-31). The cards can be acquired for the purpose of withdrawing cash (column 10, lines 32-35).

It would have been obvious to a person of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Downing of giving a code to a beneficiary to

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include using single use codes to pick smart cards with pins as taught by Corder and Risafi because it provides for secure transmission of funds to a user using readily accessible machines and allows the beneficiary to only take cash from the transferred funds when needed.

Further, as discussed above, Downing discloses that the CAT machines have card readers and that the structure generally corresponds to those found in conventional ATM machines (column 4, lines 61 thru column 5, line 6). Therefore, the technical ability exists to combined the elements as claimed and the results of the combination are predictable. *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (U.S. April 30, 2007).

For these reasons, Applicant's argument that Downing teaches away is not persuasive and therefore the rejection under Downing, in view of Corder, in view of Risafi is maintained.

7. Applicant argues that the combination of elements from the cited prior fails to disclose Applicant's invention because a critical element's function outside the combination is altered within the combination. This argument is addressed above, but the Examiner reasserts the position here. Downing teaches away from Corder and Risafi and requiring a money pick up device and pin. The Examiner respectfully disagrees. It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Downing, Corder and Risafi are all in the field of Applicant's endeavor and related to the particular problem with which Applicant is concerned. Applicant's specification states that a need exists in the art for a money transfer system that is significantly easier and quicker to use by both transferring parties and beneficiaries. Downing teaches an

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invention for a system and method for convenient funds transfers (column 3, lines 40-53).

Corder teaches a system and method for transferring value that easy for customers to use and relatively inexpensive for business to install and maintain (column 1, line 64-67 and column 2, line 66 thru column 3, line 30). Risafi teaches that the invention is used for transferring money between two cardholders (column 5, lines 11-17). Therefore, Downing, Corder and Risafi are all in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. Therefore the prior art is analogous.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3, 8-10, 14, 16, 18, 20, 24-26, 30-34, 40-44, 49, 50 and 62-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Downing et al. (hereinafter Downing) U.S. Patent 5,963,647 in view of Corder et al. (hereinafter Corder) U.S. Patent 5,936,221 in further view of Risafi et al. (hereinafter Risafi) U.S. Patent 6,473,500.

Regarding claims 1, 8, 14, 18, 20, 24, 33, 34, 42 and 62-64, Downing teaches a method for transferring a sum of money from a customer to a beneficiary via a money-transfer company,

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a network of money dispensing machines and corresponding personal codes capable of selective operations of said money dispensing machines, said method comprising: collecting said sum of money, via said money-transfer company, from a customer for transfer to a beneficiary (column 6, lines 18-47 and column 10, lines 37-63) and providing said beneficiary with a unique device pick-up code (column 7, lines 6-17). Downing then teaches that the recipient uses another CAT machine to receive the funds. While the CAT machines have card readers (column 4, lines 61-67), it is not required that the recipient use a card to access the funds. Specifically, Downing teaches a secret code selected by the sender at the time the transfer was requested as well as a transfer confirmation reference number generated by the system and printed on the receipt (column 7, lines 6-17). The beneficiary then uses a CAT and enters the secret code and reference number to obtain the request funds (column 7, lines 29-42). While Downing teaches that use of a CAT, which allows the beneficiary to obtain funds without a card/PIN, Downing also teaches that invention can be used in connections with ATMs (column 10, lines 34-36). Downing teaches the use of a PIN when reading the card of the transferor (column 10, lines 37-47). Downing further teaches differentiating pick-up codes from the sender's PIN to increase security in the system (column 9, lines 57-64). Downing fails to teach using a single-use device pick-up code to obtain a money pick-up device.

Corder teaches a smart card system for transferring value (Abstract and title).

Specifically, Corder teaches that a customer telephones the central server apparatus and requests a transfer of value, i.e. money from a pre-established account of the customer at a bank, to an account of the entity operating the stored value system (column 4, lines 27-44). After funds are verified, an authorization code (i.e. single use pick-up code) is provided to the customer (column

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4, lines 54-67). Corder further teaches that once an authorization code is provided to a customer, the authorization code is deactivated, so that it cannot be provided to other customers (column 5, lines 3-8: single use). Continuing, the customer then goes to a value added terminal (ATM) and inputs the authorization code and the value added terminal can either obtain a supply of smart cards from which it can select one and program the card with the appropriate dollar amount (column 5, lines 22-33). After the value added terminal programs the smart card with the cash value, the authorization code is deactivated in a manner similar with the deactivation mentioned earlier (column 5, lines 46-54; Therefore the code can only be used one for a single transaction). The card is then dispensed to the customer who can use the card as electronic or digital cash at any number of money activated machines (column 6, lines 15-25). Corder fails to teach that the authorization code is provided from the customer to a beneficiary and instead the customer picks up the card himself. However, it would have been obvious to a person of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Downing of giving a code to a beneficiary to include using single use codes to pick smart cards as taught by Corder because it provides for secure transmission of funds to a user using readily accessible machines and allows the beneficiary to only take cash from the transferred funds when needed.

Downing fails to teach personal codes. Corder teaches that each smart card is programmed with a specific code that is recognized by value added terminals as being the code of the present invention and thus when a customer inserts a smart card into a value added terminal, the terminal verifies that the card is authorized for use (column 6, lines 15-25). Corder fails to teach that this is a personal code.

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Risafi teaches that a card can be used to transfer money (column 9, lines 51-57). Risafi teaches cards can be purchased at a point of sale location, at an ATM, at any designated/approved card-dispensing device or from a card issuer or designated agent of the card issuer (column 6, lines 47-57). Risafi teaches issuing by a program sponsor to a card user a card with a PIN, in which the consumer (beneficiary) can even change the PIN if desired (column 6, lines 58-65). Risafi teaches that the card can be used to transfer money, including wire transfer (column 9, lines 27-57). Risafi also teaches that a program sponsor can cause the card to be issued on behalf of a card user and assign a PIN to the card (column 6, lines 48-64). Risafi teaches that issuers or agents can sell or distribute card to card users or they can be obtained at a standalone terminal (column 10, lines 1-31). The cards can be acquired for the purpose of withdrawing cash (column 10, lines 32-35). Therefore it would have been obvious to a person of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Downing in view or Corder to include the personal code teachings of Risafi because it provides for secure transactions when using the card at a ATM machine.

Claims 2, 9, and 25, Downing fails to teach obtaining a money pick-up device with a personal code. Risafi teaches obtaining cards with a personal code that is pre-assigned (column 6, lines 48-64). Specifically Risafi teaches that the card can be obtained via a third party (POS, ATM, dispensing device, designated agent of the card issuer) where the user may then select a PIN. Therefore Risafi does teach the ability for the beneficiary to acquire the necessary card/information, not directly from the transferor. Corder teaches a smart card system for

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transferring value (Abstract and title). Specifically, Corder teaches that a customer telephones the central server apparatus and requests a transfer of value, i.e. money from a pre-established account of the customer at a bank, to an account of the entity operating the stored value system (column 4, lines 27-44). After funds are verified, an authorization code (i.e. single use pick-up code) is provided to the customer (column 4, lines 54-67). Corder further teaches that once an authorization code is provided to a customer, the authorization code is deactivated, so that it cannot be provided to other customers (column 5, lines 3-8: single use). Continuing, the customer then goes to a value added terminal (ATM) and inputs the authorization code and the value added terminal can either obtain a supply of smart cards from which it can select one and program the card with the appropriate dollar amount (column 5, lines 22-33). After the value added terminal programs the smart card with the cash value, the authorization code is deactivated in a manner similar with the deactivation mentioned earlier (column 5, lines 46-54; Therefore the code can only be used one for a single transaction). The card is then dispensed to the customer who can use the card as electronic or digital cash at any number of money activated machines (column 6, lines 15-25).

Claims 3 and 10, Downing teaches a method and system for transferring funds from an account to an individual in which a beneficiary utilizes a reference number and secret code provided by the sender to access the transferred funds (column 7, lines 29-42). Corder teaches that each smart card is programmed with a specific code that is recognized by value added terminals as being the code of the present invention and thus when a customer inserts a smart

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card into a value added terminal, the terminal verifies that the card is authorized for use (column 6, lines 15-25).

Claim 16, Downing fails to teach obtaining a money pick-up device with a personal code and activating the device. Corder teaches that each smart card is programmed with a specific code that is recognized by value added terminals as being the code of the present invention and thus when a customer inserts a smart card into a value added terminal, the terminal verifies that the card is authorized for use (column 6, lines 15-25). Risafi teaches activating of money pick-up device (column 10, lines 32-67).

Claims 20 and 26, Downing teaches a method and system for transferring funds from an account to an individual in which a beneficiary utilizes a reference number and secret code provided by the sender to access the transferred funds (column 7, lines 29-42).

Claims 30-32, Corder teaches that each smart card is programmed with a specific code that is recognized by value added terminals as being the code of the present invention and thus when a customer inserts a smart card into a value added terminal, the terminal verifies that the card is authorized for use (column 6, lines 15-25). Risafi teaches the step of activating one of said money pick-up devices includes the step of the distributor selecting a money pick-up device from an inventory of money-pick up devices, and activating the money pick-up devices selected from the inventory (column 10, lines 33-67).

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Claim 43, Downing teaches the financial instrument is an instrument representative of a funds-transfer (column 5, lines 16-22).

Claims 44, Downing in view of Candor fail to teach that the financial instrument is a check. Risafi teaches that the cards can be obtained via a check. Downing, Risafi and Candor fail to teach the funds-access code is for a check. Official Notice is taken that transferring funds via check is old and well known in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Downing, Candor and Risafi to include transferring funds via check because it allows an accessible way to transfer funds from one party to another.

Claims 40, 41, 49, and 50, Downing teaches specifying a selected recipient and associating the financial instrument with the recipient (column 7, lines 6-41).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEFANOS KARMIS whose telephone number is (571)272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted
/Stefanos Karmis/
Primary Examiner, Art Unit 3693
22 June 2009